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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

GREEN, BRIAN

ART UNIT PAPER NUMBER

3611

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/626,082

Applicant(s)

EBY ET AL.

Examiner

Brian K. Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2004 and 24 July 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

The drawings filed on 6/24/2004 are non-compliant with 37 CFR 1.121 since the applicant failed to identify in the top margin of each drawing sheet as "Replacement Sheet".

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the easel defined in claims 10-12 and 26 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to because in figure 1 the hole/opening in the lower portion of the flexible sheet (12) should be labeled with a numeral and lead line. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: the specification fails to include the heading "Summary of the Invention" and a summary of the invention section. On page 4, line 19, "36" should be "34".

Appropriate correction is required.

Claim Objections

Claims 13-27 are objected to because of the following informalities: In claim 13, line 2, and claim 19, line 6, "a first" should be "first". In claim 14, line 1, "wherein rectangular substrate" should be "wherein the rectangular substrate" to make it clear that the applicant is referring to the same substrate mentioned in claim 13. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 19-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 19, lines 7-9 are misdescriptive since the second ply does not include first and second tabs adapted to engage the back surface of the substrate as suggested in these lines. The applicant clearly defines in the specification on page 6 that the tab (76) on the second ply engages the first ply.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,4,8,9,19, and 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Eckstein et al. (U.S. Patent No. 4,085,534).

Eckstein et al. shows in figures 1-2 a cascable file jacket comprising a flexible substrate (9) having first and second surfaces, a file pocket adjacent to the first surface (in figure 1, the first

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surface is considered to be the back surface of substrate 9 and can not be seen in figure 1) and including a first ply (3) foldably connected (the tab 4 is folded and received within an opening 5 in the second ply) to a second ply (3, an adjacent ply to the first ply), a first tab (6) formed integrally to the first ply and adapted to fixedly engage the file pocket to the second surface (the front surface shown in figure 1 is considered to be the second surface), and a second tab formed integrally to the second ply and adapted to expandably engage the file pocket to the second surface. In regard to claim 2, Eckstein et al. shows first and second mounting holes (10). In regard to claims 4 and 21, Eckstein et al. shows in figure 1 a third mounting hole (10, mounting holes 10 are placed along the left and right vertical edges of the substrate 9, see figure 1). In regard to claim 5, the file pocket is “adapted” to accept at least one piece of 8.5 by 11.0 inch paper. In regard to claim 8, the first and second tabs (6) are fixed to the substrate. The particular method used to attach the tabs is not given patentable weight in an article. In regard to claims 9 and 22, as broadly defined, the tab (5) is folded and the back surface of the folded tab is considered to include a label portion, i.e. a portion which can receive a label. In regard to claim 19, the upper end of Eckstein et al. is considered to be a “narrow” end. In regard to claim 23, Eckstein et al. shows a third tab (4). In regard to claim 24, as broadly defined, a portion of the tab (6) and substrate 9 can pivot slightly relative to the clamping bars (8) which is considered to form an expandable portion and the rest of the tab (6) is secured to the substrate by the clamp (8). In regard to claim 25, Eckstein et al. shows in figure 1 the idea of attaching additional expanding file pockets.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3,6,7,13-18,20, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckstein et al. (U.S. Patent No. 4,085,534) in view of Able (U.S. Patent No. 6,349,491).

In regard to claims 3 and 20, Eckstein et al. does not disclose placing a grommet in each of the first and second mounting holes. Able shows in figure 1 the idea of placing grommets (40) in the first and second mounting holes. In view of the teachings of Able it would have been obvious to one in the art to modify Eckstein et al. by placing a grommet in each of the first and second mounting holes since this would help to prevent the flexible sheet from tearing in the area around the mounting holes. In regard to claim 6, Eckstein et al. does not disclose whether the flexible substrate is formed from polypropylene. Able discloses in column 5, lines 59-64, the idea of making the base 12 and sections 14 out of flexible polypropylene. In view of the teachings of Able it would have been obvious to one in the art to modify Eckstein et al. by making the flexible substrate out of polypropylene since this would create a stronger and more durable substrate. In regard to claims 7 and 13, Eckstein et al. does not disclose whether the file pocket is formed from a poly-sheet material. Able discloses in column 5, lines 59-64, the idea of making the base 12 and sections 14 out of flexible polypropylene. In view of the teachings of Able it would have been obvious to one in the art to modify Eckstein et al. by making the pocket out of poly-sheet material since this would create a stronger and more durable pocket. In regard to claim 13, the substrate (9) is considered to include a "narrow" end. In regard to claims 13 and

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27, Eckstein et al. does not disclose folding a poly-sheet to form first and second plies which form a pocket. Eckstein et al. discloses the idea of securing a first and a second sheet together to form a pocket. It would have been an obvious matter of design choice to modify Eckstein et al. by forming the first and second plies by folding a single sheet since the applicant fails to define any advantage to forming the pocket from a single folded sheet and the pocket formed from two separate sheets as taught by Eckstein et al. would work equally well. In regard to claim 13, Eckstein et al. discloses the use of a first tab (6) on the first ply, a second tab (6) on the second ply (the ply attached to the first ply), and a third tab (4) for connecting the first and second plies together. In regard to claim 14, Eckstein et al. shows in figure 1 a third mounting hole (10, mounting holes 10 are placed along the left and right vertical edges of the substrate 9, see figure 1). In regard to claim 15, as broadly defined, a portion of the tab (6) and substrate 9 can pivot slightly relative to the clamping bars (8) which is considered to form an expandable portion. The method used to attach the tab to the back surface is not given any weight in an article claim. In regard to claim 16, as broadly defined, the tab (5) is folded and the back surface of the folded tab is considered to include a label portion, i.e. a portion which can receive a label. In regard to claim 17, Eckstein et al. does not disclose placing a grommet in each of the first and second mounting holes. Able shows in figure 1 the idea of placing grommets (40) in the first and second mounting holes. In view of the teachings of Able it would have been obvious to one in the art to modify Eckstein et al. by placing a grommet in each of the first and second mounting holes since this would help to prevent the flexible sheet from tearing in the area around the mounting holes. In regard to claim 18, Eckstein et al. does not disclose whether the flexible substrate is formed from polypropylene. Able discloses in column 5, lines 59-64, the idea of making the base 12 and

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sections 14 out of flexible polypropylene. In view of the teachings of Able it would have been obvious to one in the art to modify Eckstein et al. by making the flexible substrate out of polypropylene since this would create a stronger and more durable substrate.

Claims 10-12 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckstein et al. (U.S. Patent No. 4,085,534) in view of Young (U.S. Patent No. 4,226,039).

Eckstein et al. does not disclose attaching an easel to the flexible substrate. Young shows in figure 1 the idea of attaching an easel (7) to a flexible substrate. In view of the teachings of Young it would have been obvious to one in the art to modify Eckstein et al. by attaching an easel to the flexible substrate since this would allow the substrate to be displayed in an upright and vertical manner which would allow the sheets placed within the pockets to be seen in a better manner. In regard to claim 11, Young shows in figure 1 that the easel includes at least one inclined leg. In regard to claim 12, Young shows in figure 1 that the easel is a foldable triangular stand.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ruffino, Miller, Westberg, Strassberg, and Buechele teach the use of a cascable file jacket. Amberg teaches the use of a sheet that includes grommets received within mounting holes.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (703) 308-1011. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BRIAN K. GREEN
PRIMARY EXAMINER

Bkg
Sept. 30, 2004